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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/484,260	01/18/2000	Thomas C. Gipson	P-355.5(REISSUE)	9484
26271 7590 07/27/2007 FULBRIGHT & JAWORSKI, LLP 1301 MCKINNEY SUITE 5100 HOUSTON, TX 77010-3095			EXAMINER SUCHFIELD, GEORGE A	
			ART UNIT 3676	PAPER NUMBER
			MAIL DATE 07/27/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/484,260 ; 10/005,708

Applicant(s)

GIPSON, THOMAS C.

Examiner

George Suchfield

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-9 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,839,514 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

3. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The most recent declaration, i.e., the substitute declaration filed on January 26, 2006 is deemed, overall, drawn to a broadening reissue application. It is noted, however, that the original reissue declaration identified the reissue application as a "narrowing" reissue, i.e., by asserting "the original patent to be partly invalid by reason of the patentee claiming more than the patentee had a right to claim in the patent". Such original declaration was accompanied by a narrowing of the patent claims comprising the cancellation of claims 1-3 and 10. Any or all subsequent amendment(s) which instead broadened the patent claims, such as amendment filed on June 18, 2003, were not filed within the two-year statutory period.

Thus, the reissue declaration must, instead, be drawn to a “narrowing” reissue, while still indicating at least one error upon which the reissue application is based.

4. Claims 4-9 and 11 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

5. Claims 4-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 4, as amended (dated May 21, 2007), includes terms or subject matter not present in the specification and/or original disclosure. More specifically, no basis can be found in the specification or original disclosure for a frame comprising a mast and a lower frame, and wherein the mast is pivotally mounted on such lower frame and an injector reel is rotatably mounted on the mast, as now called for in claim 4. In this regard, the embodiment represented by Figures 1-6 do not include a “lower” frame. In the alternative embodiment illustrated by Figures 7-10, while a lower frame (84) is provided, which further includes a mast (38) pivotally mounted to such lower frame (note Figure 9), clearly such mast does not then also include “an injector reel rotatably mounted onto said mast”. Instead, such alternative embodiment, as illustrated in, e.g., Figure 9, merely depicts the mast (38) as being attached to the upper frame (82), with injector reel (34) rotatably mounted to an upper frame (82).

Claims 5-9 are similarly rejected as they depend from claim 4. Otherwise, the additional limitations recited in claims 5-9 are deemed supported by the specification and/or original disclosure, and appear to fall within the alternative embodiment, as noted above, and/or comprise features or limitations common to all the embodiments of applicant's invention.

6. Claims 4-7 and 9 are rejected under 35 U.S.C 102(b) as being anticipated by the Vita Brochure.

The Vita Brochure depict the overall structure of coil tubing injector including a frame with a front and back end (note the illustrations on page 4 of the Vita Brochure) and both an injector reel and a coil tubing storage spool or reel. The photographs, e.g., on pages 2 and 3 of the Brochure, clearly illustrate the tubing storage reel removably mounted on the back end of said frame, a mast pivotally mounted on the frame, and an injector reel rotatably mounted on the mast wherein the injector reel is pivotable between a stored position at the front end of the frame to a second tubing injection position located above the frame. The Vita Brochure appears to further provide a drive mechanism to rotate the injector reel. In this regard, note the illustrations on page 4 of the Vita Brochure, and also the reference to a "Drive" under the coiled tubing injector unit specifications. With respect to the hold down assembly recited in claim 4, the pictures and illustrations of the Vita Brochure (note pages 3 and 4) clearly illustrate the coil tubing injector reel having an assembly of "multiple adjusted tensioned rollers" for exerting pressure on the coil tubing, and which is mounted over "more than 900 of the circumference" of the coil tubing injector reel, as recited. Also with regard to claim 4, in the photograph on page 2 of the Vita Brochure labeled "Dual Units Killing Steam Well Without Wellhead", the coil tubing injector unit pictured on the right appears to show the injector reel in a second or operating

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position wherein the coil tubing exits the injector reel "at an angle less than 90° to said surface", as called for in claim 4.

As per claim 5, the photographs of page 1 and page 3 labeled "CTU on Location in Japan" of the Vita Brochure appear to indicate the first tubing stabilizer and second tubing stabilizer, as recited. Note particularly the photograph on page 3 appears to depict two distinct, i.e., upper and lower coiled tubing stabilizers.

As per claim 6, the picture on page 2 of the Vita Brochure labeled "Storage/Work Reel in Traversing Position" depicts a tubing storage spool cradle having pictured opposed pivotable bullnose arms for the tubing storage spool.

As per claim 7, said pictured opposed pivotable bullnose arms appear adjustable in a horizontal direction, i.e., normal to the axis of the frame, due to the hydraulic cylinder and telescoping tubing sections depicted comprising a front portion of the tubing storage spool cradle or frame.

As per claim 9, insofar as the drive mechanism pictured in the Vita Brochure and described on page 4 of the Vita Brochure as a "sprocket & chain final drive", it would inherently be adjustable, as recited, e.g., by removing or adding links in the drive chain.

7. Applicant's arguments filed with the amendment have been fully considered but they are not persuasive.

With respect to the reissue declaration, it is noted that the most recent reissue declaration submitted on January 26, 2006 was designated as a "substitute" reissue declaration. Hence, applicant must complete a new, "narrowing" reissue declaration. Moreover, the submitted copy of the reissue declaration of December 23, 2002 further includes markings or delineations, which

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are unacceptable. Also, in view of the date of submission of the original reissue declaration, it must be deemed "stale" relative to the submission date of applicant's most recent amendment of May 21, 2007. In addition, the reissue declaration of December 23, 2002 is inaccurate insofar as the claim language recited for amended claim 4 in the declaration does not correspond to claim 4 as most recently amended in the May 21, 2007 Amendment.

With regard to applicant's argument that the cited prior art does not teach or suggest an apparatus and method for conducting coiled tubing operations "wherein the coiled tubing is at an angle of less than 90° to the surface" is not concurred in. As noted above in Para 6), in the photograph on page 2 of the Vita Brochure labeled "Dual Units Killing Steam Well Without Wellhead", the coil tubing injector unit pictured on the right appears to show the injector reel in a second or operating position wherein the coil tubing exits the injector reel "at an angle less than 90° to said surface", as called for in independent claim 4.

8. Claim 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims, because the Vita Brochure or prior art of record does not appear to depict opposed pivotable bullnose arms which are "vertically slidably attached" to the coiled tubing apparatus frame or tubing storage cradle, as recited in claim 8.

9. Claim 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 251. The Vita Brochure or prior art of record similarly is similarly not deemed to teach or disclose the limitation in claim 11 wherein a tubing storage spool is mounted on a cradle "vertically and horizontally adjustable to accept varying spool widths and diameters", as recited.

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10. In view of the long prosecution history and extraneous record due, at least in part, to the previous introduction of broadening claims at a point in time beyond the two-year period allowed for broadening reissue(s), and which was inadvertently permitted to be prosecuted and go forward by the examiner, this action will not be made final. Any subsequent action(s) and/or rejection, however, will be made final, as appropriate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Suchfield whose telephone number is 571-272-7036. The examiner can normally be reached on M-F (6:30 - 3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


George Suchfield
Primary Examiner
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Gs
June 30, 2007